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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GIBBONS P.C. ONE GATEWAY CENTER NEWARK, NJ 07102				
EXAMINER				
NGUYEN, TAN D				
ART UNIT		PAPER NUMBER		
3689				
NOTIFICATION DATE		DELIVERY MODE		
11/25/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDocket@gibbonslaw.com

Office Action Summary

Application No.

10/673,697

Applicant(s)

BRENNEN ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 24-37 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 38-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 12/19/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 12/19/03 was filed after the mailing date of the application on 9/29/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Election/Restrictions

2. Applicant's election with traverse of Group I, claims 1-23 and 38-49 in the reply filed on 8/27/09 is acknowledged. The traversal is on the ground(s) that it's not a serious burden. This is not found persuasive because it's a serious burden for the examiner to examine 3 distinct inventions as indicated in the restriction of 2/27/09.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-23 and 38-49 are pending. They comprise 2 groups:

- 1) system: 1-23, and
- 2) method: 38-49.

Method claim 38 is as followed:

38. A method for implementing a plurality of programs, each having a program manager, wherein each program is offered to a user and is supported by supporting suppliers/vendors, said method comprising the steps of:

- a) authenticating the program manager of each program,
- b) authenticating the user of each program,

- c) authenticating the supporting suppliers/vendors of each program;
- d) permitting the user to initiate a program and review selected program information of programs for which the user is authorized to access;
- e) permitting the supporting suppliers/vendors to monitor selected program information of programs which the supporting suppliers/vendors are authorized to access;
- f) permitting the program manager to manage a program and to access selected program information of programs for which the program manager is authorized to access; and
- g) permitting a service provider to access and control selected program information, wherein the service provider engages the supporting suppliers/vendors to support the program.

Note: for convenience, letters (a)-(g) are added to the beginning of each step.

3. Note also that the “permitting” clause: “permitting the user to initiate” is merely giving the permission to carry out a task and not doing the task itself. In other word, “permitting/allowing an action” is different from actually “performing an action”. “Allowing”, “causing” or “permitting” only requires “serving as the reason” for an “action” though, not necessarily performing the action. This can be done by issuing commands or orders, or entering into contracts. So even though the entity may do

something later with the equipment that is in the technological arts, the positively recited steps of merely "causing" can be done without operating the equipment and is not in the technological arts. Variations on this theme have been seen in other cases, using terms like "allowing" or "permitting" an action, e.g. "allowing a user to search a database". Again, these functions (elements or steps) are distinct from actually doing the action, e.g. "modifying the input data..." and the current claim language has no such function or structural element calling for "configured to modify" or "step/means for modifying".

Note: In claim 38, steps (a)-(g), the phrase "...to initiate..." or "to review ...", or "to access" is not a positively recited method step but, rather, is mere intended use of the permitted user and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Note: that it appears that independent claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in

terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Cir. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Current claims 1-23 comprise: a platform, a management system, interface, gateway, a front end, proprietary application, data repository, program managers, a meeting manager, an attendee registration engine, sales manager, global distribution system, etc., which are basically software components. There are no citations of an apparatus or structural elements or devices such as processor or computer or computer server.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

The independent claim 1 begin by discussing an apparatus (a technology platform), comprising elements such as a management system, but the body of the claim contains method steps, "permitting", "is authorized", "to initiate", "to monitor", "to

manage", "permitting", and "engages", etc, or respectively use language that is used in the claims of a method. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

Similarly, dep. claims 2-23, which contain many method steps such as: "driven", "managing", "authenticates", "permitting", "interfaces", "access", "is selected", "presents", "access", "pulling", "scheduling", and "coordinating", "maintains", "working", "budgets", "applying", "is pushed or pulled", "pulling data", "pushing data", "interfacing", or respectively use language that is used in the claims of a method. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 112

8. **Claims 1-23** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) **Claims 1-23** are vague and indefinite since the dependent claims uses "method steps" such as "permitting", "is authorized", "to initiate", "to monitor", "to manage", "permitting", and "engages", etc, etc., in an apparatus claims. See IPXL Holdings. Va. Amazon.com (Fed. Circuit 2005). System claim that includes a method step is invalid as indefinite since it's not clear what is the scope of the apparatus claim.

Note: In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 38-49 (method) are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must:

(1) be tied to a particular machine or apparatus or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

(a) To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

(b) There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

(c) Here, applicant's method steps fail the first prong of the new test because there is not tie at all to a particular machine or apparatus. The only alleged tie in dep. claims 42-49 is with a data repository or a management system, which are not apparatus, and are directed to insignificant extra solution activities and is insufficient to render the otherwise ineligible process claim as statutory).

(d) Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 38-49 (method), 1-23 (apparatus) are rejected under 35 U.S.C. 103(a) as being unpatentable over LAN.

As for independent method claim 38, LAN fairly discloses a method for implementing a plurality of programs, each having a program manager, wherein each program is offered to a user and is supported by supporting suppliers/vendors, said method comprising the steps of:

- a) involve/collaborate/control/monitor program manager of each program,
- b) involve/collaborate/control/monitor the user of each program,
- c) involve/collaborate/control/monitor the supporting suppliers/vendors of each program;

{see Figs. 1, pars. [0045-0046] which allows collaboration between various parties, and to communicate, control, monitor, and on-line collaboration using "Web Office"}

- d) permitting the user [to initiate a program and review selected program information of programs for which the user is authorized to access];

{see Fig. 1, pars. [0036-0038], [0405-0410]}

- e) permitting the supporting suppliers/vendors [to monitor selected program information of programs which the supporting suppliers/vendors are authorized to access];

{see Fig. 1, pars. [00236-00250]}

f) permitting the program manager [to manage a program and to access selected program information of programs for which the program manager is authorized to access]; and

{see Fig. 1, pars. [0065-0091]}

g) permitting a service provider [to access and control selected program information, wherein the service provider engages the supporting suppliers/vendors to support the program.]

{see Fig. 1, pars. [0036-0038], [0330-0343]}

Note that the bracket [...] is used to indicate intended use phrase and not positive recitation of a method step.

LAN fairly teaches the claimed invention except for using the term "authenticating" in the collaborate/monitor function of steps (a)-(c) above. However, in view of the usage of collaborative web tools such as Web Office, and the general goal of monitoring and controlling the collaboration among the specific parties, it would have been obvious to include the function of "authenticating" in the collaborating/monitoring steps for proper monitoring of the collaboration on line and effectively meeting clients' requirement {see pars. [0030-0037]}.

As for dep. claim 39 (part of 38 above), which deals with managing the different parties involved, users, this is taught in Figs. 1, 3, pars. [0036-0046].

As for dep. claim 40 (part of 38 above), which deals with authenticating other user, this is discussed in the rejection of claim 38 above and in view of pars. [0030-0037].

As for dep. claim 41 (part of 38 above), which deals with providing a web page to the user for communication, this is taught in Fig. 2, 5, pars. [0046], [0142-0153], and [0320-0360].

As for dep. claim 39 (part of 38 above), which deals with managing the different parties involved, users, this is taught in Figs. 1, 3, pars. [0036-0046].

As for dep. claims 42-44 (part of 38 above), which deal with permitting the various involved parties to access information, these are taught in Figs. 1, 3, pars. [0036-0037].

As for dep. claims 45-48 (part of 38 above), which deal with various application and meeting (conference) operation center, these are taught in Figs. 2, 5, pars. [0046], [0169-0171], [0189], especially par. [0199].

As for dep. claim 41 (part of 38 above), which deals with providing an interface, this is taught on pars. [0198].

As for independent system claim 1, which is basically the system to carry out the independent method claim 38 above, it's rejected over the system of LAN, Figs. 1-2, to used for carrying out the rejection of method steps of claim 38 above.

As for dep. claims 2-23 (part of 1 above), which basically have similar limitations as in dep. claims 39-49 (part of 38 above), they are rejected for the same reasons set forth above.

No claims are allowed.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

1. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

2. Any response to this action should be mailed to:

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3. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

4. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number **(571) 272-6806**. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at **(571) 272-6805**. The main **FAX phone** numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is **(571) 273-6806**. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689